

REMARKS

Reconsideration of the present application is respectfully requested. Claim 20, this claim has been amended to include the limitation previously presented as claim 26. Claims 1 – 32 and 34 - 39 are currently pending.

Rejections based on 35 U.S.C. § 103

Claims 1 – 6, 20, 22, 34 – 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Edelman, US Patent No. 5,680,563 (“Edelman”), in view of Bolnick, *et al.*, US Patent No. 5,838,317 (“Bolnick”) and further in view of Shiomi, *et al.*, US Patent No. 6,009,439 (“Shiomi”) and further in view of Adcock, *et al.*, US Publn. No. 2004/0125150 (“Adcock”). Applicants respectfully traverse the pending rejection.

The Cited References Fail to Teach the Claimed “Listing”

The independent claims require “a listing of said one or more group titles, wherein said listing indicates which of said groups contain the filtered digital images that are currently being presented in the digital image presentation area.” To teach the claimed “listing”, the Office Action relies on Adcock. Office Action, p. 7.

The interface of Adcock includes a left-hand pane that includes a calendar.¹ Adcock, Fig. 7. The Office Action relies on this left-hand pane calendar to teach the claimed listing, stating “Adcock discloses a listing of group titles that indicate (by title and coloring, see

¹ In a right-hand pane, Adcock displays images in groups (along with group titles in the form of placeholders 711b 721b, 731b, ect.). Adcock, Fig. 7. The presentation of images in groups with group titles clearly does not read on the claimed “listing of said one or more group titles, wherein said listing indicates which of said groups contain the filtered digital images that are currently being presented in the digital image presentation area.”

Page 2, Paragraph [0025]) which of the groups of images are currently presented.” Office Action, p. 7.

However, nowhere does Paragraph 25 of Adcock teach displaying a listing of group titles. Rather, Paragraph 25 teaches changing the visual appearance of a calendar entry to indicate the quantity of digital images associated with that entry. A review of Fig. 7 confirms that Adcock does not contemplate the claimed listing of group titles because only a single group title is displayed along with the left-hand/calendar pane. Finally, a review of Fig. 7 further reveals that the interface of Adcock does not indicate “which of said groups contain the filtered digital images,” as required by the independent claims. Given the numerous differences between Adcock’s interface and the claimed “listing,” Applicants respectfully submit that the prior art fails to teach or suggest the limitations recited by independent claims 1, 20 and 34.

The Cited References Fail to Teach the Claimed Interface

Independent claim 20 requires “a digital image presentation area” which (1) “displays at least a portion of said filtered digital images to the user in accordance with the default grouping associated with a selected filter, wherein said digital image presentation area also displays at least a portion of said one or more group titles” and (2) “further presents a listing of said one or more group titles, wherein said listing indicates which of said groups contain the filtered digital images that are currently being presented in the digital image presentation area.” Similar claim language is also found in independent claims 1 and 34. The references, either alone or in combination, fail to teach or suggest the multiple aspects of the claimed “a digital image presentation area.”

As indicated above, the claims recite an interface in which **both** (1) images are presented in groups with group titles and (2) a listing of group titles is further presented, where

the listing indicated which are the groups contain currently presented images. None of the references teach or suggest this combination of interface features. Tellingly, the Office Action relies on the Bolnick reference to teach the presentation of images with group titles but relies on Adcock to teach the claimed listing. The interface of Bolnick, however, does not contemplate a separate listing of group titles on the interface. Bolnick, Fig. 1. Nor does Adcock teach or suggest such a separate listing of group titles to accompany the presentation of images in groups. Adcock, Fig. 7. In sum, the prior art fails to teach an interface in which both (1) images are presented in groups with group titles and (2) a listing of group titles is further presented, where the listing indicated which are the groups contain currently presented images, as required by the claims. For this additional reason, Applicants respectfully submit independent claims 1, 20 and 34 are in condition for allowance.

Taken as a Whole, the Claimed Invention is Novel Over the Prior Art.

To address various problems in the art surrounding presentation of grouped items, the independent claims recite a novel interface for presenting a plurality of items to a user. Though several of the features of this interface may be found in prior art references, Section 103 precludes the “hindsight discounting of the value of new combinations by requiring ***assessment of the invention as a whole.***” *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004)(emphasis added). Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements.”). For example, as discussed in the previous section, the claims combine a “listing” with the display of groups and headers to yield a novel interface that is not suggested by the prior art. As such, Applicants respectfully submit

that the claims combine “various existing features or principles in a new way to achieve a new result,” which is “the very definition of invention.” *Ruiz*, 357 F.3d at 1275.

For the reasons set forth above, Applicant respectfully submits that claims 1, 20 and 34 are in condition for allowance. As to claim 20, this claim has been amended to include the limitation previously presented as claim 26, namely “wherein said default grouping utilizes one or more gaps in time to group the filtered digital images.” Those the Office Action relies on *yet another reference*, Engst, to teach this limitation, Applicants respectfully submit that Engst use of film rolls does not teach the claimed use gaps in time to group items. See Engst, p.10 – 12. For this additional reason, claim 20 is in condition for allowance.

Applicants further submit that dependent claims 2 - 6, which depend from claim 1, are in condition for allowance for at least the same reasons discussed above with respect to claim 1. Applicants further submit that dependent claim 22, which depends from claim 20, is in condition for allowance for at least the same reasons discussed above with respect to claim 20. Applicants further submit that dependent claim 36, which depends from claim 34, is in condition for allowance for at least the same reasons discussed above with respect to claim 34.

Dependant Claims 7 – 19, 21, 23 – 32, 35 and 37 – 39

Dependent claims 7 – 19, 21, 23 – 32, 35 and 37 – 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Edelman in view of Bolnick, and in further view of Shiomi, and further in view of Adcock, and further in view of Engst (“iPhoto 2 for Mac OS X: Visual Quickstart Guide”, Copyright 04/21/2003, Peachpit Press). Claims 7 – 19, 21, 23 – 32, 35 and 37 – 39 each depend from either independent claims 1, 20 or 34. As discussed above, claims 1, 20 and 34 are patentable over the combination of Edelman, Bolnick, Shiomi and Adcock. Engst also fails to disclose the invention of claims 1, 20 and 34, individually or in combination

with Edelman, Bolnick, Shiomi and Adcock. Claims 7 – 19, 21, 23 – 32, 35 and 37 – 39 include all of the limitations of either claim 1, 20 or 34 and, thus, are also patentable over Edelman, Bolnick, Shiomi, Adcock and Engst, taken separately or in combination with one another, for at least the reasons stated above.

Conclusion

For the reasons stated above, claims 1 – 32 and 34 - 39 are in condition for allowance. If any issues remain which would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,

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